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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,415	02/14/2005	Jeremy Nicholas Ness	056222-5070	4449
9629 7590 06/24/2009 MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004				
EXAMINER				
SOROUSH, ALI				
ART UNIT		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/524,415

**Applicant(s)**

NESS ET AL.

**Examiner**

ALI SOROUSH

**Art Unit**

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 11-13, 15-17, 19, 20, 22, 24-29, 36-38, 40-42, 44, 45 and 49-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 11-13, 15-17, 22, 24-29, 36-38, 40-42, 49-56 and 59 is/are rejected.
- 7) ☒ Claim(s) 19, 20, 44, 45, 57 and 58 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/26/2009 has been entered.

### ***Status of the Claims***

Claims 1, 15, 16, 19, 22, 24, 28, 40, 41, 44, 49, and 57 are currently amended and claims 5-10, 14, 18, 21, 23, 30-35, 39, 43, and 46-48 are cancelled. Therefore, claims 1-4, 11-13, 15-17, 19, 20, 22, 24-29, 36-38, 40-42, 44, 45, and 49-59 are currently pending examination for patentability.

Rejections and/or objections not reiterated from the previous Office Action are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set of rejections and/or objections presently being applied to the instant application.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Applicant Claims
2. Determining the scope and contents of the prior art.
3. Ascertaining the differences between the prior art and the claims at issue; and resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

1. The rejection of claims 1-4, 11-13, 15-17, 22, 24-29, 36-38, 40-42, 49-56, and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ness et al. (US Patent 6194375 B1, Published 02/27/2001) in view of Natske et al. (International Application Published Under the PCT WO 96/03041, Published 02/08/1996) **is maintained.**

### ***Applicant Claims***

Applicant claims an aminoplast capsule having an inner coating and outer coating encapsulating a perfume.

### ***Determination of the Scope and Content of the Prior Art (MPEP §2141.01)***

Ness et al. teaches the formation of capsules of perfume is by polymerization reaction at the interface between the droplets and the aqueous phase and further having polyvinyl alcohol at the surface of the capsule. (See column 6, Lines 40-55). The perfume includes solvents and is in a weight ratio of 1:30 or 1:20 to 1:2 or

1:1 relative to the shell polymer. (See column 9, Lines 24-28 and 48-51). In a preferred embodiment the perfume composition taught by Ness et al. comprises 5.3% Cithrathal concentrate, 32.0 % Linalol, 30.2% Linalyl acetate, 26.5% orange oil all of which have an octanol-water coefficient between 3 and 5. (See column 24, Lines 40-45). These encapsulated perfumes were mixed in to make perfumed shampoos including 1% of the encapsulate. (See column 24, Lines 63-66).

***Ascertainment of the Difference Between Scope the Prior Art and the Claims  
(MPEP §2141.012)***

The composition of Ness et al. is an aminoplast capsule having an outer coating with a perfume composition in a surfactant containing hair shampoo. Ness et al. however lacks a teaching of the capsule having an inner coating. Natske et al. cures this deficiency.

Natske et al. is discussed above.

***Finding of Prima Facie Obviousness Rational and Motivation  
(MPEP §2142-2143)***

It would have been obvious to one of ordinary skill in the art to combine the teachings of Ness with Natske et al. One would have been motivated to do so because Natske et al. teaches that an inner coating of wax in an aminoplast capsule provides for greater long-term stability. Therefore, one would expect that the addition of an inner wax coating to the aminoplast capsule of Ness would also be expected to provide greater stability of the encapsulated perfume in a shampoo composition. For the foregoing

reasons, the instant composition would have been obvious to one of ordinary skill in the art at the time of the instant invention.

***Response to Applicant's Arguments***

Applicant argues that there is no motivation to combine the teachings of Ness et al. with Natske et al. in order to arrive at a shell capsule with an inner surface coating encapsulating a perfume. Applicant argues that the capsule used to retain herbicides would not lead one of ordinary skill in the art to modify capsules used to retain perfume in a similar way. Applicant's arguments have been fully considered and found not to be persuasive. The teaching of Natske et al. is directed to enhancing the long term stability of microcapsules by applying an inner microcapsule wall made of a wax. Such an inner wall hinders the penetration of water into the capsule. (See page 2, Lines 10-25). The examiner has relied on the teachings of Natske et al. in order to modify a microcapsule, particularly an aminoplast, to increase the stability of the capsule. Since the modification with the wax is done to the capsule it would be obvious to one of ordinary skill in the art to also modify any similar capsule for any other use. Furthermore, the Examiner notes that Natske et al. teach the encapsulation of biologically active compounds and are not limited to just the exemplified herbicides. For the foregoing reasons, the rejection of claims 1-4, 11-13, 15-17, 22, 24-29, 36-38, 40-42, 49-56, and 59 under 35 U.S.C. 103(a) is maintained.

***New Grounds of Rejection***

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 22 and 49 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 22 recites the broad recitation **polymer of the outer coating is water-soluble**, and the claim also recites **coating of polyvinyl alcohol, polyvinylpyrrolidone or copolymer of polyvinylpyrrolidone on the outer surface of the shell wall** which is the narrower statement of the range/limitation.

Claim 49 is indefinite for not making clear whether the polymers disclosed are used to form the outer coating or the inner coating on the aminoplast.

***Allowable Subject Matter***

Claims 19, 20, 44, 45, 57, and 58 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 19, 20, 44, 45, 57, and 58 are allowable because the prior art does not teach or suggest an aminoplast capsule having an inner coating of film forming polymer selected from the group consisting of: poly(ethylene-maleic anhydride), polyamine, polyvinylpyrrolidone, polyvinylpyrrolidone-ethyl acrylate, polyvinylpyrrolidone-vinyl acrylate, polyvinylpyrrolidone methylacrylate, polyvinylpyrrolidone/vinyl acetate, polyvinyl acetal, polyvinyl butyral, polysiloxane, poly(propylene/maleic anhydride), maleic anhydride derivatives and polyvinyl methyl ether/maleic anhydride.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ali Soroush whose telephone number is (571) 272-9925. The examiner can normally be reached on Monday through Thursday 8:30am to 5:00pm E.S.T.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Johann Richter can be reached on (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent



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Ali Soroush  
Patent Examiner  
Art Unit: 1616

/Johann R. Richter/

Supervisory Patent Examiner, Art Unit 1616